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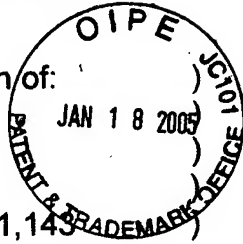
In re Patent Application of:

Shaolin Li

Application No.: 10/821,143

Filed: April 7, 2004

For: MULTI-ANTENNA WIRELESS
DATA PROCESSING SYSTEM



ATTORNEY REVIEWING:
PAUL SHANOSKI

BEST AVAILABLE COPY

REQUEST FOR RECONSIDERATION OF PETITION
UNDER 37 C.F.R. § 1.47(b)

COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir,

Applicant respectfully submits this Request for Reconsideration of Petition Under 37 C.F.R. § 1.47 (b) and a one month extension of time for reply.

The above named application is related to the following four other applications all of which claim priority to the same provisional application 10/820,961, 10/820,962, 10/820,963 and 10/821,038. The provisional application is 60/461,170.

Applicant respectfully submits that the original petition met the requirements of 37 C.F.R. § 1.47 (b). However, as noted in the Decision on Petition Under 37 C.F.R. § 1.47 (b) mailed October 13, 2004 (Decision on Petition), the Office reasons that the Applicant has met a substantial portion of the requirements of 37 C.F.R. § 1.47(b) but not all. Specifically, the Office

reasons that the Applicant has met (1)-(5) of (8) stated in the Decision on Petition.^{1,2}

Per the Office's request, Applicant respectfully submits that this response to the Decision on Petition further meets requirements (6)-(8) of the Decision on Petition. With this response Applicant submits; a further showing that the Rule 47(b) applicant has sufficient proprietary interest in the subject matter to justify the filing of the application, further proof of irreparable damage, and an acceptable declaration in compliance with 35 U.S.C. §§ 115 and 116 and 37 CFR § 1.63.

In the Decision on Petition, the Office stated that the applicant "has not established sufficient proprietary interest in the subject matter to justify the filing of the application" because the "petitioner has not established that the non-signing inventor assigned his rights to Epogy Communications, Inc." Applicant respectfully submits that the Declaration by J. Nicholas Gross In Re: Application No. 10/821,143 (Declaration) addresses the particular points raised by the Office. The Declaration is attached for your review at Exhibit 1.

¹ Decision on Petition Under 37 CFR § 1.47 (b), paragraph 4, page 2.

² A grantable petition under 37 C.F.R. § 1.47 (b) requires:

- (1) The petition fee;
- (2) a surcharge if the petition was not filed at the time of filing of the application;
- (3) a statement of the last known address of each of the non-signing inventors;
- (4) proof that a copy of the application was sent or given to each of the non-signing inventors for review;
- (5) proof that each of the non-signing inventors refused to sign;
- (6) proof that rule 47(b) applicant has sufficient proprietary interest in the subject matter to justify the filing of the application;
- (7) proof of irreparable damage, and;
- (8) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116 and 37 CFR § 1.63

J. Nicholas Gross (Mr. Gross) was the patent attorney for Epogy who drafted the 10/821,143 patent application and the provisional application 60/461,170 from which it claims priority.³

The Office points out that the Epogy employment agreement states that an employee is required during the course of his employment, to "assign all inventions which are: conceived, developed, or reduced to practice during the time of his employment with Epogy, and are either: related to the business of the employer or his anticipated research or development; are developed with company equipment or on company time, or; resulted from any work performed by the employee for the employer."⁴ The employment agreement is attached for your review at Exhibit 2. The Office further states that there is no proof that the inventor was employed by Epogy at the time that the invention was conceived, developed, or reduced to practice.⁵

Applicant respectfully submits that the Declaration addresses the particular points raised by the Office regarding the previous petition.

First, the inventor was employed by Epogy at the time the invention was conceived and reduced to practice. In his declaration, Mr. Gross states that the inventor, Dr. Shaolin Li, conceived of and/or reduced to practice the invention and such inventions; (1) during a time Dr. Li was an employee of Epogy; (2) based on work he performed on Epogy's behalf and not some other capacity; and (3) while he was under contractual obligation to assign any invention rights.⁶

³ Declaration By J. Nicholas Gross In Re: Application No. 10/821,143, page 1, paragraphs 2 and 3 and page 2, paragraph 10.

⁴ Decision on Petition Under 37 CFR § 1.47 (b), paragraph 6, page 2.

⁵ Id. paragraph 7, page 2.

⁶ Declaration By J. Nicholas Gross In Re: Application No. 10/821,143, page 2, paragraph 18.

Second, the invention was related to the business of Epogy. In his declaration, Mr. Gross states that he met with Dr. Shaolin Li and other employees of Epogy on a number of occasions to “discuss the nature of the innovations at Epogy.”⁷ Further, Mr. Gross states that he had a conversation with the president of Epogy, Mr. Homer Chang, during which Mr. Chang told him that Epogy was “designing a new WiFi ASIC device for use in a high speed wireless access point.”⁸ Additionally, in Exhibit A pages 59-70 of the Declaration is an Epogy presentation describing Epogy technologies as relating to wireless communications.

Third, the invention was developed on company time. In the declaration Mr. Gross points out that Dr. Shaolin Li confirmed “that he was the author of the technical materials” which formed part of the provisional application 60/461,170 that the current application claims priority from⁹ and “that such materials were created during the course of his work on the MIMO ASIC project” for Epogy.¹⁰ Further, Dr. Shaolin Li “was specifically instructed to assist” Mr. Gross “with the process of drafting and filing a patent application to cover the inventions he conceived and/or reduced to practice at Epogy in connection with the MIMO ASIC.”¹¹

Finally, the invention arose from work performed by the non-signing inventor. The president of Epogy, Mr. Chang stated that Dr. Shaolin Li was the

⁷ Id. at page 2, paragraph 9.

⁸ Id. at page 3, paragraph 18.

⁹ Declaration By J. Nicholas Gross In Re: Application No. 10/821,143, page 1, paragraphs 5, 9.

¹⁰ Id., page 2, paragraph 9, page 1, paragraphs 4 and 7.

¹¹ Id., page 2, paragraph 10

head of the design team for the ASIC project at Epogy.¹² Later, Dr. Li “confirmed that he was the author of the technical materials” and that “such materials were created during the course of his work on the MIMO ASIC project, and that the company expected to file patent applications to cover portions of such work.”¹³

In the Decision on Petition under 37 C.F.R. § 1.47 (b) the Office required proof of irreparable damage. Applicant respectfully submits that the filing of this application without the signature of inventor Dr. Shaolin Li is necessary to preserve the rights of the parties.

Additionally, in the Decision on Petition the Office required an oath or declaration compliant with 37 CFR §1.63. Please find attached the required Declaration compliant with 37 CFR §1.63 and executed by Julia Ceffalo who is authorized to act on behalf of the assignee, Bellows Bellows, LLC. Ms. Ceffalo's signature complies with 37 CFR 3.73(b)(2)(i).

¹² Id., page 1, paragraph 7.

¹³ Id., page 2, paragraph 9.

Finally, please find enclosed a Change of Correspondence Address
executed by Howard Skaist, an attorney of record in this matter.

Respectfully submitted,

BERKELEY LAW & TECHNOLOGY GROUP, LLC

Dated: 1/13/05



Howard A. Skaist
Reg. No. 36,008

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BY: ME

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UNITED STATES PATENT AND TRADEMARK OFFICE
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ALEXANDRIA, VA 22313-1450
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Paper No. None

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SAN FRANCISCO CA 94117

COPY MAILED

OCT 13 2004

OFFICE OF PETITIONS

In re Application of	:	
Shaolin Li	:	
Application No. 10/821,143	:	DECISION ON PETITION
Filed: April 7, 2004	:	UNDER 37 C.F.R. §1.47(b)
Attorney Docket No. Epogy 2004-1	:	
Title: MULTI-ANTENNA WIRELESS	:	
DATA PROCESSING SYSTEM	:	

This is in response to the petition under 37 CFR §1.47(b)¹, filed August 27, 2004.

The above-identified application was filed on April 7, 2004. On June 22, 2004, applicant was mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted" (Notice), requiring an executed oath or declaration in compliance with §1.63 and a surcharge for its late filing. This Notice set a two-month period for reply.

In reply, applicant filed the instant petition on August 27, 2004, along with the surcharge, a statement of the last known address of the inventor, a statement that a complete copy of the application was sent to the non-signing inventor, and a copy of the inventor's employment agreement.

1 1 A grantable petition under 37 CFR §1.47(b) requires:

- (1) The petition fee;
- (2) a surcharge if the petition was not filed at the time of filing of the application;
- (3) a statement of the last known address of each of the non-signing inventors;
- (4) proof that a copy of the application was sent or given to each of the non-signing inventors for review;
- (5) proof that each of the non-signing inventors refused to sign;
- (6) proof that the Rule 47(b) applicant has sufficient proprietary interest in the subject matter to justify the filing of the application;
- (7) proof of irreparable damage, and;
- (8) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116 and 37 CFR §1.63.

The petition fee has been charged to Petitioner's Deposit Account.

Petitioner states that a copy of the application was sent to the inventor. The Office will assume that this copy was a complete copy. Secondly, Petitioner states that his firm mailed the application to the inventor. The Office will assume that he personally sent the package to the inventor, and makes this statement as one who has firsthand knowledge of the underlying event.

Furthermore, it is noted that Petitioner has not explicitly stated whether the inventor cannot be found or whether he refuses to cooperate. However, since a complete copy of the application was sent to the inventor, and since a search did not result in any alternate address, the Office will assume that Petitioner is asserting that the inventor refuses to cooperate. Petitioner must notify the Office if these interpretations are incorrect.

Petitioner has met requirements (1) – (5) above.

Regarding the sixth requirement above, Rule 47 applicant has not established sufficient proprietary interest in the subject matter to justify the filing of the application, in that the chain of title is not complete². Petitioner has not established that the non-signing inventor assigned his rights to Epogy Communications, Inc, the first of three purported assignees.

First, the agreement states that during the course of his employment, the employee will assign all inventions which are: conceived, developed, or reduced to practice during the time of his employment with Epogy,³ and are either: related to the business of the employer⁴ or his anticipated research or development;⁵ are developed with company equipment or on company time⁶, or; resulted from any work performed by the employee for the employer⁷.

Regarding the first element above, no proof has been submitted that the inventor was employed by Epogy at the time that the invention was conceived, developed, or reduced to practice.

Regarding the second and third elements above, no statement has been made to establish that the present invention falls within these parameters. The Office has no way of determining if this invention has anything to do with the business of the employer, or if the invention was made on company time.

Regarding the final element above, it has not been established that this invention arose from any work performed by the non-signing inventor or Epogy, since all that is known about either is that the inventor was employed as a Senior Member of Technical Staff, in the vaguely titled Technical Development and Design department.

² See 37 C.F.R. §3.73(b).

³ Agreement, paragraph 8, page 2.

⁴ Agreement, paragraph 8, page 3.

⁵ Id.

⁶ Id.

⁷ Id.

Regarding the seventh requirement above, no proof of irreparable damage has been submitted⁸. A statement by Rule 47(b) applicant that the filing is necessary to preserve the rights of the parties would be sufficient.

Regarding the eighth requirement above, it is noted that to date, it does not appear that Petitioner has submitted either an oath or declaration. Petitioner will note that the filing of a petition under 37 C.F.R. §1.47(b) does not allow the applicant to escape the requirements of 37 C.F.R. §1.63

Rule 47(b) applicant must make the required oath or declaration. The declaration must state the relationship of the person, making the oath or declaration, to the inventor, and upon information and belief, the facts which the inventor is required to state. Where a corporation is the 47(b) applicant, an officer thereof should normally sign the necessary oath or declaration. Regardless, the title or position of the person signing must be stated. Where an oath or declaration is signed by a registered attorney or agent on behalf of a corporation, either proof of the attorney's or agent's authority in the form of a statement signed by an appropriate corporate officer must be submitted, or the attorney or agent may simply state that he or she is authorized to sign on behalf of the corporation. Where the oath or declaration is being signed on behalf of an assignee, see MPEP §324. See also MPEP §409.03(b). Submission of an oath or declaration in compliance with 37 C.F.R. §§1.63 and 1.64 is required.

As such, the petition is **DISMISSED**.

On renewed petition, the petitioner should: establish sufficient proprietary interest or submit a legal memorandum signed by an attorney familiar with the law of the jurisdiction stating that a court of competent jurisdiction would, by the weight of the authority, award title to the invention to the Rule 47(b) applicant; provide proof of irreparable damage, and; submit an acceptable oath or declaration.

Rule 47 applicant is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(b)," and should only address the deficiencies noted above, except that the reply may include an oath or declaration executed by the non-signing inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 C.F.R. §1.136(a).

The reply to this letter may be submitted by mail⁹, hand-delivery¹⁰, or facsimile¹¹.

The application file will be retained in the Office of Petitions for two (2) months.

It is noted that the address listed on the petition differs from the address of record. A change of correspondence address has been filed with this petition. However, the request was not signed by an attorney of record, but rather by one "Julia Ceffalo, Authorized Person, Bellow Bellows

⁸ See MPEP §409.03(g).

⁹ Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

¹⁰ Customer Window, Mail Stop Petition, Crystal Plaza Two, Lobby, Room 1B03, Arlington, Virginia 22202

¹¹ (703) 872-9306.

LLC.” Since the chain of title is incomplete, this request will not be entered. Should the Petitioner, who is listed as an attorney of record, wish to receive future correspondence regarding this application, he should execute and submit a change of correspondence address. A courtesy copy of this decision will be mailed to petitioner. However, all future correspondence will be directed to the address of record until such time as appropriate instructions are received to the contrary. Petitioner will not receive future correspondence unless a Change of Correspondence Address Form (PTO/SB/122) is submitted for the above-identified application. A blank Change of Correspondence Address Form (PTO/SB/122) may be found at <http://www.uspto.gov/web/forms/sb0122.pdf>.

The general phone number for the Office of Petitions which should be used for status requests is (571) 272-3282. Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3225.



Paul Shanowski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office

cc: Howard A. Skaist
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5250 NE Elam Young Parkway, #850
Hillsboro, OR 97124